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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,220	08/20/2003	Jay G. Geertsen	43407.0007	7222
57600	7590	01/11/2008	EXAMINER	
HOLLAND & HART LLP P.O. Box 11583 60 E. South Temple, Suite 2000 Salt Lake City, UT 84110			SAINDON, WILLIAM V	
			ART UNIT	PAPER NUMBER
			3623	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/645,220	GEERTSEN ET AL.
	Examiner	Art Unit
	William V. Saindon	3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 August 2003.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-28 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/22/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following NON FINAL Office Action is in response to Applicant's submission received August 22, 2003. Claims 1-28 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 15-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claims are directed towards software per se and not tangibly embodied in a computer readable medium. No hardware elements such as a computer are claimed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

As to claim 1, element E refers to "said one or more items of system data," but no items of system data were previously claimed. Therefore, it is unclear what this element refers to. The Examiner will construe this element to refer to the one or more items of

local service provider data. Furthermore, the claim, in element F, refers to “a said local service provider gateway.” This is unclear because it fails to use proper antecedent basis. The Examiner will construe this element to refer to --said local service provider gateway.--

As to claim 6, “wherein generating said message...” is recited, but no message was generated in claim 1. The Examiner will construe this element to refer to element D of claim 1.

All other claims are rejected for containing the same or similar deficiencies, or depending from a claim with the same or similar deficiencies.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruckdashel (US 6,038,542).

As to claim 1, Ruckdashel discloses a method for sending service provider specific messages comprising:

A. scheduling an appointment in a reminder scheduler (see Fig. 5, item 501, “user schedules events”);

- B. getting one or more items of customer data associated with said appointment (see id., noting that if a user schedules an event he or she provides data associated with themselves or they could not schedule the event);
- C. retrieving one or more items of local service provider data based on said one or more items of customer data (see Fig. 5, item 507, noting the user provides data for the local service provider that would provide the user with notification);
- D. creating a message in said reminder scheduler using said one or more items of local service provider data and said one or more items of customer data (see Fig. 9, item 907, noting that the user is sent a message);
- E. determining from said one or more items of customer data and said one or more items of system data a local service provider gateway (see Fig. 9, item 906, noting that the appropriate provider gateway is notified such that the user can get the message); and
- F. sending said message based on said appointment to a said local service provider gateway (see Fig. 9, item 907, noting the user is sent a message).

As to claim 2, Ruckdashel discloses sending said message from said local service provider gateway to a messaging device (see Fig. 7, noting that a cell phone is a messaging device).

As to claim 3, Ruckdashel discloses said messaging device is selected from the group consisting of a telephone, a pager, and an e-mail system (see id., noting that a cell phone is a telephone).

As to claim 4, Ruckdashel discloses said message is selected from the group consisting of a text message, an e-mail message, and a pager message (see id., noting that pagers receive pages).

As to claim 5, Ruckdashel discloses at least one of said one or more items of customer data is a telephone number (see id., noting item 707 where a telephone number is provided).

As to claim 6, Ruckdashel discloses generating said message is based on a rules engine (see Fig. 9, noting that the rule used is if a notification time has occurred, then send a notification).

As to claim 7, Ruckdashel discloses messages are sent at configurable times (see id., noting that the time that the message is sent is when the designated [configured] time has arrived).

As to claim 8, Ruckdashel discloses creating said message is based on a template (see col. 5, lines 24-39, noting the user configures the appropriate template for notification).

As to claim 9, Ruckdashel discloses sending said message is based on a template (see Fig. 9, noting that a message is always sent when appropriate, following a template of always sending a message when appropriate).

As to claim 10, Ruckdashel discloses one or more items of subscriber data is in a database (see col. 4, lines 14-25, noting that the information is stored in a database).

As to claim 11, Ruckdashel discloses messages are sent over a network (see Fig. 1, noting a lan/wan is used).

As to claim 12, Ruckdashel discloses said network is the Internet (see id., noting a wan is used, a wan includes the internet).

As to claim 13, Ruckdashel discloses scheduling an appointment on a Graphical User Interface (see Fig. 1, item 106, noting displays are how the user inputs information. See also Figs 6 or 7).

As to claim 14, Ruckdashel discloses importing said customer data from a practice management system (see Fig. 6, noting that schedule data is input via a schedule management system, the schedule being about a business practice).

Claims 15-28 are rejected for similar reasons as claims 1-14, respectively.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Loucks (US 6,760,412) discloses an event reminder program that attempts to remind via email, pager, phone, fax, etc.

Hogan et al. (US 5,646,982) discloses a system for message delivery according to a scheduler.

Silver et al. (US 7,260,189) discloses a system for information provision to various devices in order to remind.

Li et al. (US 6,182,041) disclose a text to speech reminder system delivering using email, voicemail, or phone.

Zhang et al. (US 6,016,478) disclose a scheduling system with reminders sent to various devices.

Ford et al. (US 6,480,830) disclose a calendar system that sends messages to users based on various rules.

Perrella et al. (US 7,139,722; 2003/0004776) disclose time sensitive wireless calendaring including messaging.

Victoria Franklin et al., "Sweet Talk": Text Messaging Support for Intensive Insulin Therapy for Young People with Diabetes," *Diabetes Tech. & Therapeutics*, vol. 5, iss. 6, p. 991 (2003), disclose a text messaging reminder system for a person with diabetes to take scheduled actions.

Owen Dyer, "Patients will be reminded of appointments by text messages," 326 *BMJ* 326 (June 14, 2003), discloses using text messages to remind people of appointments.

Communitect Web Site, various pages, various dates, discloses TopSpin MRS and Smile Reminder, two text message reminder systems disclosed by assignee.

9. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Saindon whose telephone number is (571) 270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/



BETH VAN DOREN
PRIMARY EXAMINER

Request for Information under 37 CFR § 1.105

10. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

Specifically, the Examiner has become aware that the assignee has at least offered to sell, via website, TopSpin MRS (Mobile Reminder Service), Smile Reminder, and NEXT-m. See the Communitect Web Site reference. Both of these products use text messaging to remind users of appointments. These two products align largely with the disclosed invention. Therefore, this request for information is required to distinguish between these two products and the present invention.

11. In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:

A. When did applicants and/or assignee first publicly disclose TopSpin MRS?

This includes, but is not limited to, product manuals, web sites, pamphlets, marketing materials, and the like. Please provide a copy of all such materials relating to TopSpin MRS that were publicly available before the effective filing date of the present application.

B. When did applicants and/or assignee first publicly disclose Smile Reminder?

This includes, but is not limited to, product manuals, web sites, pamphlets, marketing materials, and the like. Please provide a copy of all such materials relating to Smile Reminder that were publicly available before the effective filing date of the present application.

C. When did applicants and/or assignee first publicly disclose NEXT-m? This includes, but is not limited to, product manuals, web sites, pamphlets, marketing materials, and the like. Please provide a copy of all such materials relating to NEXT-m that were publicly available before the effective filing date of the present application.

D. Was TopSpin MRS in public use or on sale more than a year before the effective filing date of the present invention?

E. Was Smile Reminder in public use or on sale more than a year before the effective filing date of the present invention?

F. Was NEXT-m in public use or on sale more than a year before the effective filing date of the present invention?

12. The information is required to identify products and services embodying the disclosed subject matter and identify the properties of similar products and services found in the prior art.

13. In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.

14. In response to this requirement, please state the specific improvements of the subject matter in claims 1-28 over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those improvements. For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure which describe the claimed structure and acts. Especially focus on the TopSpin, Smile Reminder, and NEXT-m products.

15. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

16. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

17. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

18. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

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/wvs/



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600